



# RESTRICTION ELECTION FACSIMILE TRANSMISSION

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GROUP 1600

DATE: 16 November 1998

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COMMENTS: Restriction Response with Transmittal  
Advice Change.

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David L. Fox  
Reg. No. 40,612  
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|--------------|--|---|----------------------|--------------|
| SERIAL NO.:  | 08/765,695   | § | DOCKET NO. P-0125US0 | FAX RECEIVED |
| FILING DATE: | JULY 25, 1997  | § | EXAMINER:            | NUV 17 1998  |
| APPLICANT:   | LARS ABRAHMSEN,<br>ET AL.  | § | R. SCHWADRON         | GROUP 1600   |
| TITLE:       | "CONJUGATE BETWEEN<br>A MODIFIED SUPERANTIGEN<br>AND A TARGET-SEEKING<br>COMPOUND AND THE USE OF<br>THE CONJUGATE" | § |                      |              |

The Honorable Commissioner of  
Patents and Trademarks  
Washington, D.C. 20231

**RESPONSE, WITH TRAVERSE, TO WRITTEN  
RESTRICTION REQUIREMENT**

This communication is responsive to a written restriction requirement mailed October 16, 1998. It is timely by being filed on or before November 16, 1998. Applicants respectfully note that the Examiner proposed restriction of the claims into two groups, Group I, encompassing claims 14 -35, drawn to a conjugate, and Group II, encompassing claims 36-51, drawn to a *in vivo* method of treatment using the conjugate.

Applicants provisionally elect prosecution of Group II (claims 36-51 drawn to an *in vivo* method of treatment using a conjugate). However, as explained in more detail below, Applicants respectfully traverse the restriction requirement, and respectfully aver that there is unity of invention and all claims should therefore be examined in a single application.

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Applicants' traverse; the subject restriction requirement is not based upon a proper reading of PCT Rule 13.

Applicants note that the Examiner has drawn a restriction between so called Groups I and II based upon the "special technical feature" linking both groups being the conjugate of Group I. The Examiner then goes on to cite Buelow, et al., as teaching a protein A-SEB conjugate which, apparently, the Examiner alleges discloses at least a species under the broadest conjugate claims.

Applicants agree, at this time, that the "special technical feature" linking Groups I and II is the conjugate of Group I. However, Applicants respectfully, and strenuously, disagree with the Examiner's basis for drawing a distinction between Groups I and II, based upon his assertion that the conjugate of Group I is not patentable over the prior art.

That is, the Examiner appears to be basing the restriction requirement between Groups I and II upon an assertion that the broadest claims of Group I (the conjugate claims) may not be patentable over the prior art. Again, apparently, this is because the Examiner is asserting that Buelow, et al., teaches a conjugate which may read upon at least a species captured under the broadest claims of Group I.

Applicants respectfully do not agree with this position regarding Buelow and do not acquiesce. Furthermore, Applicants expressly retain the right to argue about the patentability of the broadest subject matter of the present claims during substantive examination of the claims (when such arguments are proper and appropriate). At this time, Applicants merely note that it is incorrect for the Examiner to draw a distinction between claims of Groups I and II by alleging that perhaps, the broadest claims of Group I (the conjugate) may not be patentable over the prior art (for example, due to anticipation of a single alleged species by Buelow). The complete claimed conjugate invention,

when viewed as a whole, contains subject matter that is clearly patentable over the prior art, including Buelow. For example, claim 9 indicates that one embodiment of the conjugate invention may include antibody-superantigen conjugate. These conjugates (for example) are clearly patentable over Buelow (which only discloses a protein A-superantigen conjugate and does not disclose or suggest an antibody-superantigen conjugate).

For the Examiner to determine that there are two separate inventions not linked by a feature patentable over the prior art based solely upon the examination of the broadest claims in each alleged group is improper under the very rule by which the Examiner supports his position. That is, PCT Rule 13 expressly addresses this point of unity of invention. That is, PCT Rule 13.2 defines the expression "special technical features" to mean "those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art." Furthermore, PCT Rule 13.3 expressly mandates that "the determination of whether a group of inventions is so linked as to form a single general event of concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives in a single claim."

That is, under the appropriate PCT rules, the Examiner is to look at the inventions as a whole, and not just to the broadest claims of a group.

What the Examiner is apparently doing in the present case is using his contention that the broadest claims of Group I conjugates may not be patentable over the prior art, and therefore, there is no technical feature between the two groups which would be patentable over the prior art. This is squarely incorrect given the present PCT rules. Clearly from viewing the invention as a whole of both defined Groups I and II, one can see that the "conjugate" of the present invention clearly encompasses subject matter patentable over Buelow. For example, while the broad claims refer

generally to a "biospecific affinity counterpart" conjugated with a modified superantigen, additional claims which fully define the claimed invention further set forth that the "biospecific affinity counterpart" may be selected from the group consisting of, for example, an antibody or an antigen binding fragment (see, for example, claims 9 and 32). Buelow does not disclose or render unpatentable a conjugate between a modified superantigen and an antibody.

Therefore, Applicants respectfully assert that when the invention is viewed as a whole, it is apparent that the two defined groups by the Examiner (the method and product groups I and II) are, in fact, linked by a "special technical feature" which comprises the conjugate of claim 1, which is patentable over the prior art.

Therefore, reconsideration of the restriction requirement, and removal of the restriction requirement is respectfully requested. Applicants therefore respectfully request that the Examiner review pending claims 14-51 as the proper unit in which they are presented, and issue the first substantive office action on this unified invention.

Applicants respectfully petition for any extension of time necessary to render this response timely.

Please charge any fees due or credit any overpayment to the standing account of Fulbright & Jaworski L.L.P., Deposit No. 06-2375 under Order No. 984877.

Respectfully submitted,



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Date: 16 November 1998

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